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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,923	11/06/2001	H. Darrel Darby	A7971	4566

7590 06/18/2004  
SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
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PHAM, HUONG Q

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/985,923

Applicant(s)

DARBY, H. DARREL

Examiner

Huong Q. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Michael. As for claim 1, Michael shows every claimed feature of claim 1 including an outer sole 13 ( figures 3, 4), a rigid immobilization plate 12, a boot portion 15 or 26 . As for claims 6 - 7, note the liner 27. As for claim 10, note the boot portion 26 ( figure 4).

Claims 1, 2, 4, 6- 8, 10, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Oster et al. Oster et al teaches every claimed feature of claims 1, 19 including an outer sole 42 ( figure 4), a rigid immobilization plate 30 with a back portion 34( figure 2), a boot portion 26 ( figure 5), strap 90 & means for attaching the strap. As for claims 2, 4, note figure s 2, 5. As for claim 6, note figure 6. As for claim 7, note that "breathable " is a relative term.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12-14, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael. Michael shows every claimed feature of claims 11, 13, 14, 18( including a lower insole 28) except for an upper removable insole. Note that after market, additional shoe inserts are available for removably attached to the top of a lower insole of a shoe. It would have been obvious to an ordinary skill in the art at the time the invention was made to provide an additional upper removable insole to the device of Michael for additional cushioning. Also, note that it is obvious to make the lower insole 28 of Michael removable for the purpose of replacing the insole. As for claim 12, official notice is taken that the recited structure of the outer sole is well known in the art.

Claims 2-5, 9, 15-17, 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael in view of Darby et al or Oster et al. Darby et al and Oster et al teach ventilation ports for a brace. In view of the teaching of Darby or Oster et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide the brace of Michael with a ventilation port for ventilation. The provision of a port to a structure for the purpose of providing ventilation is well known, and provides no unexpected result, and therefore is not patentably distinct from prior art. As for claim 9, note that the boot of Darby et al is made of polyurethane. As for claims 16- 17, note the liner 26 ( figures 3, 4 ) of

Michael. As for claim 19-28, Michael teaches the structure as claimed except for the fastening means with the lock portion and buckle. Darby et al teaches this type of fastening means for a brace. In view of the teaching of Darby et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the fastening means 31, 32 of Michael with the fastening means of Darby et al. The substitution of one type of fastening means for another well-known type of fastening means in the art is a matter of obvious engineering design choice.

Claims 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oster et al in view of Darby et al. While Oster et al does not teach the recited fastening means of claims 20-28, Darby et al teaches this type of fastening means for a brace. In view of the teaching of Darby et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the fastening means 90 of Oster et al with the fastening means of Darby et al. The substitution of one type of fastening means for another well-known type of fastening means in the art is a matter of obvious engineering design choice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (703) 305-5129. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on ( 703) 308 - 2698. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 6, 2004



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